

**Remarks**

The Office Action mailed June 3, 2005 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-35 and 37-46 are now pending in this application. Claims 1-46 stand rejected. Claim 36 has been canceled.

In accordance with 37 C.F.R. 1.136(a), a two month extension of time is submitted herewith to extend the due date of the response to the Office Action dated June 3, 2005, for the above-identified patent application from September 3, 2005, through and including November 3, 2005. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of \$450.00 to cover this extension of time request also is submitted herewith.

The rejection of Claim 9 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Applicant respectfully submits that Claim 9 satisfies section 112, second paragraph. More specifically, Applicant respectfully submits that Claim 9 is definite and particularly points out and distinctly claims the subject matter of the invention. However, Applicant has amended Claim 9 to address this rejection. Accordingly, Applicant submits that Claim 9 satisfies section 112, second paragraph. For at least the reasons set forth above, Applicant respectfully requests that the rejection of Claim 9 under 35 U.S.C. § 112, second paragraph, be withdrawn.

The rejection of Claims 1-34 and 42-43 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is respectfully traversed.

The Office Action asserts at page 2 that Claims 1-34 and 42-43 are rejected “because the claimed invention is directed to non-statutory subject matter.” Applicant respectfully traverses this assertion. However, Applicant has amended independent Claims 1 and 42 to address the rejection set forth in the Office Action.

More specifically, Applicant submit that the claims of the present patent application are directed to practical applications in the technological arts. “Any sequence of operational steps can constitute a process within the meaning of the Patent Act so long as it is part of the

technological arts.” In re Musgrave, 431 F.2d 882 (C.C.P.A. 1970). For example, independent Claim 1 is a method for managing email content using an email server, an email induction server and a graphics database. Applicant submits that a method for managing email content is a useful process that is considered to be within “the technological arts”.

One specific example of such a method implementation is a computer with a processor programmed to at least one of receive an email, electronically monitor the email received for email content, automatically extract the content of the email, and load the content of the email into a graphics database, wherein the automatically extracting step includes analyzing the email to determine whether the email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format if the email includes the at least one enclosure, and converting the content of the email including the at least one enclosure having a non-graphics image format to a graphics image format. While the claims are not limited to the specific examples related to a computer with a programmed processor, the claims need not be so restricted to satisfy the requirement of Section 101.

Applicant further traverses the assertion included in the Office Action that Claims 1-34 and 42-43 are directed to non-statutory subject matter under Section 101 in light of the “Examination Guidelines for Computer-Related Inventions”. The Examination Guidelines for Computer-Related Inventions provides in relevant part as follows:

In order to determine whether the claim is limited to a practical application of an abstract idea, Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure, Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post-manipulation activity....Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Applicant respectfully submits that Claim 1 is limited to a practical application in the technological arts. Furthermore, Applicant respectfully submits that the Office Action does not expressly state how the language of Claim 1 supports the Section 101 rejection.

Claim 1 has been amended. Claim 1 recites a “a method for managing email content using an email server, an email induction server and a graphics database, the email server, the email induction server and the graphics database are in communication through a network”. Thus, Applicant submit that Claim 1 is directed to a useful process that is considered to be within “the technological arts”. Furthermore, the method includes the step of “receiving at the email server an email via the network, electronically monitoring the network email received at the email server for email content, automatically extracting the content of the network email using the email induction server...and loading the content of the network email into the graphics database accessible from the network.” Thus, Claim 1 uses an email server, a database and an email induction server to perform at least one step of the process. Claim 1 is therefore directed to a practical application in the technological arts.

Dependent Claims 2-34 depend from independent Claim 1, and these dependent Claims are submitted to satisfy the requirements of Section 101 for the same reasons set forth above with respect to independent Claim 1.

In addition, Claim 42 recites an email system for processing email for a network that includes an email server, a graphics database, and an email induction server connected in communication with the email server and the graphics database through the network, wherein the email induction server includes application software configured to perform specific steps. Claim 42 is therefore directed to a practical application in the technological arts.

Dependent Claim 43 depends from independent Claim 42, and this dependent Claim is submitted to satisfy the requirements of Section 101 for the same reasons set forth above with respect to independent Claim 42.

For at least the reasons set forth above, Applicant respectfully requests that the Section 101 rejection of Claims 1-34 and 42-43 be withdrawn.

The rejection of Claims 1, 3-4, 7, 9-16, 35-36 and 38-45 under 35 U.S.C. § 102(e) as being anticipated by Hull et al. (U.S. Patent No. 6,704,118) (“Hull”) is respectfully traversed.

Applicant respectfully submits that Hull does not describe or suggest the claimed invention. As discussed below, at least one of the differences between Hull and the present invention is that Hull does not describe or suggest a method for managing email content using an email server, an email induction server and a graphics database, wherein the email server, the email induction server and the graphics database are in communication through a network, and the method includes *automatically extracting the content of the network email using the email induction server including analyzing the network email to determine whether the network email includes at least one enclosure*. (Emphasis added.)

Moreover, Applicant submits that Hull does not describe or suggest a method for managing email content that includes *automatically extracting the content of the network email using the email induction server including determining whether the at least one enclosure is in a non-graphics image format if the network email includes at least one enclosure*. (Emphasis added.)

Furthermore, Applicant submits that Hull does not describe or suggest a method for managing email content that includes *automatically extracting the content of the network email using the email induction server including converting the content of the network email including the at least one enclosure having a non-graphics image format to a graphics image format*. (Emphasis added.)

Hull describes an automatic archiving system that makes document archiving largely transparent to the user. Documents scanned in, printed during the course of office equipment operation or emailed are automatically archived. For example, an office local area network (LAN) may interconnect a copier, a printer, a facsimile machine, and a document management workstation. Whenever, a document is copied, printed, or faxed, a document image is archived by the document management workstation without further user intervention. A single user command results in the document being copied and archived, printed and archived, or faxed and archived.

Hull describes email document archival as being performed by software on an email hub. The email hub software routes and delivers mail over networks. A configuration file can be

configured so that the email hub sends a copy of every message sent and received by a user, including the origin and destination addresses and the date and time of transmission, to the document management workstation. Thus, every document that is emailed is also archived without further user input.

Notably, Hull does not describe or suggest analyzing email to determine whether the email includes an enclosure, determining whether the enclosure is in a non-graphics image format, or converting the content of an email including enclosures having a non-graphics image format to a graphics image format.

Claim 1 recites a method for managing email content using an email server, an email induction server and a graphics database, wherein the email server, the email induction server and the graphics database are in communication through a network, the method includes “receiving at the email server an email via the network...electronically monitoring the network email received at the email server for email content...automatically extracting the content of the network email using the email induction server including...analyzing the network email to determine whether the network email includes at least one enclosure, if the network email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format, and converting the content of the network email including the at least one enclosure having a non-graphics image format to a graphics image format...and loading the content of the network email into the to a graphics database accessible from the network.”

Hull does not describe or suggest a method for managing email content using an email server, an email induction server and a graphics database, wherein the email server, the email induction server and the graphics database are in communication through a network, and the method includes *automatically extracting the content of the network email using the email induction server including analyzing the network email to determine whether the network email includes at least one enclosure.* (Emphasis added.)

Moreover, Hull does not describe or suggest a method for managing email content that includes *automatically extracting the content of the network email using the email induction*

*server including determining whether the at least one enclosure is in a non-graphics image format if the network email includes at least one enclosure. (Emphasis added.)*

Furthermore, Hull does not describe or suggest a method for managing email content that includes *automatically extracting the content of the network email using the email induction server including converting the content of the network email including the at least one enclosure having a non-graphics image format to a graphics image format. (Emphasis added.)*

Rather, Hull describes an automatic archiving system that includes archiving email documents on an email hub wherein the email hub is configured to send a copy of every message sent and received by a user, including the origin and destination addresses and the date and time of transmission, to a document management workstation. Notably, Hull does not describe or suggest analyzing the email to determine whether the email includes an enclosure, determining whether the enclosure is in a non-graphics image format, or converting the content of an email including enclosures having a non-graphics image format to a graphics image format. Accordingly, Applicant respectfully submits that Claim 1 is patentable over Hull.

For at least the reasons as set forth above, Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of Claim 1 be withdrawn.

Claims 3-4, 7 and 9-16 depend from independent Claim 1 which is submitted to be in condition for allowance. When the recitations of Claims 3-4, 7 and 9-16 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 3-4, 7 and 9-16 are also patentable over Hull.

Claim 35 recites a system for managing email content of a network that includes an email server configured to monitor incoming email of the network for content, a graphics database for storing data files, and an email induction server connected in communication with the email server and the graphics database through the network, wherein the email induction server is configured to “(a) automatically extract content from the email by...analyzing the email to determine whether the email includes at least one enclosure, and if the email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format...(b) convert the content of the email including the at least one enclosure having a non-graphics image

to a graphics image...and (c) load the content of the converted email to the graphics database accessible from the network.”

Claim 35, as herein amended, recites a system comprising, among other things, an email induction server configured to perform steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 35 is patentable over Hull for reasons that correspond to those given with respect to Claim 1.

For at least the reasons as set forth above, Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of Claim 35 be withdrawn.

Claim 36 has been canceled. Claims 38-41 depend from independent Claim 35 which is submitted to be in condition for allowance. When the recitations of Claims 38-41 are considered in combination with the recitations of Claim 35, Applicant submits that dependent Claims 38-41 are also patentable over Hull.

Claim 42 recites an email system for processing email for a network, the system including an email server configured to monitor incoming email of the network for content, a graphics database for storing data files, and an email induction server connected in communication with the email server and the graphics database through the network, the email induction server including application software configured to “analyze the email to determine whether the email includes at least one enclosure...if the email includes at least one enclosure, determine whether the at least one enclosure is in a non-graphics image format...extract content from the email...convert the content of the email including the at least one enclosure having a non-graphics image to a graphics image...and load the content of the converted email to the graphics database accessible from the network.”

Claim 42, as herein amended, recites a system comprising, among other things, an email induction server that includes application software configured to perform steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 42 is patentable over Hull for reasons that correspond to those given with respect to Claim 1.

For at least the reasons as set forth above, Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of Claim 42 be withdrawn.

Claim 43 depends from independent Claim 42 which is submitted to be in condition for allowance. When the recitations of Claim 43 are considered in combination with the recitations of Claim 42, Applicant submits that dependent Claim 43 is also patentable over Hull.

Claim 44 recites a process for memorializing email content using an email server, an email induction server and a graphics database, the email server, the email induction server and the graphics database are in communication through a network, the process includes “communicating email from a computer to the email server...automatically extracting the content of the email using the email induction server including...analyzing the email to determine whether the email includes at least one enclosure, if the email includes at least one enclosure, determining whether the at least one enclosure is in a non-graphics image format, and converting content of the email including the at least one enclosure having a non-graphics image format to one or more graphic images for storage within the graphics database in response to receiving the email at the email server...and automatically communicating acknowledgment to the email server that the content is graphically memorialized.”

Claim 44, as herein amended, recites a process for memorializing email content that includes steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 44 is patentable over Hull for reasons that correspond to those given with respect to Claim 1.

For at least the reasons as set forth above, Applicant respectfully requests that the 35 U.S.C. § 102(e) rejection of Claim 44 be withdrawn.

Claim 45 depends from independent Claim 44 which is submitted to be in condition for allowance. When the recitations of Claim 45 are considered in combination with the recitations of Claim 44, Applicant submits that dependent Claim 45 is also patentable over Hull.

For at least the reasons set forth above, Applicant respectfully requests that the Section 102 rejection of Claims 1, 3-4, 7, 9-16, 35-36 and 38-45 be withdrawn.



The rejection of Claims 5, 8, 37 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. (U.S. Patent No. 6,704,118) (“Hull”) is respectfully traversed.

Hull is described above.

Claims 5 and 8 depend from independent Claim 1. Claim 1 is recited hereinabove.

As discussed above, Hull does not describe or suggest the method recited in Claim 1. The Official Notice taken with respect to Claims 5 and 8 is traversed. Moreover, the Official Notice taken with respect to Claims 5 and 8 does not make up for the deficiencies of Hull. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 1 is patentable over Hull.

When the recitations of Claims 5 and 8 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 5 and 8 likewise are patentable over Hull.

Claim 37 depends from independent Claim 35. Claim 35 is recited hereinabove.

As discussed above, Hull does not describe or suggest the system recited in Claim 35. The Official Notice taken with respect to Claim 37 is traversed. Moreover, the Official Notice taken with respect to Claim 37 does not make up for the deficiencies of Hull. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 35 is patentable over Hull.

When the recitations of Claim 37 are considered in combination with the recitations of Claim 35, Applicant submits that dependent Claim 37 likewise is patentable over Hull.

Claim 46 depends from independent Claim 44. Claim 44 is recited hereinabove.

As discussed above, Hull does not describe or suggest the process recited in Claim 44. The Official Notice taken with respect to Claim 46 is traversed. Moreover, the Official Notice taken with respect to Claim 46 does not make up for the deficiencies of Hull. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 44 is patentable over Hull.

When the recitations of Claim 36 are considered in combination with the recitations of Claim 44, Applicant submits that dependent Claim 46 likewise is patentable over Hull.

For at least the reasons set forth above, Applicant respectfully requests that the rejection of Claims 5, 8, 37 and 46 under 35 U.S.C. § 103(a) be withdrawn.

The rejection of Claims 2, 6 and 17-34 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. (U.S. Patent No. 6,704,118) ("Hull") in view of Berchtold et al. (U.S. Patent No. 6,678,705) ("Berchtold") is respectfully traversed.

Hull is described above. Berchtold describes an architecture for document archival built on network-centric groupware such as Internet standards-based messaging. Archiving and retrieving and classifying documents into meaningful collections is accomplished in a manner similar to sending email to recipients, retrieving messages from folders, and classifying messages into folder hierarchies. In the simplest scenario, if saveme.com is the archiving server's name, then sending an email to abc@saveme.com will cause the contents of the email message to be archived in the abc mailbox. The archived documents may be automatically stored in jukeboxes of non-tamperable media such as Write Once Read Multiple (WORM) Compact Disks (CD), which provide high storage capacity, low cost compared to magnetic disks, random data access, and long-term stability.

In Berchtold, a user sends a document to be archived as an attachment to an email<sup>3</sup> addressed to the public folder that should contain the document, e.g. abc@saveme.com, where abc is the name of a public folder on the archiving server saveme.com. This can be done by specifying the folder name in any of the To:, CC:, or BCC: fields of the email. Users can use the body of the email to specify values for some pre-determined document attributes (e.g., an expense report). A script removes the body and the attached document of the message from the email server. The document itself is stored on a separate disk cache, waiting to be written out to a durable media storage device such as a CD. The body of the message is replaced by another message containing some information about the document and an address (e.g. a Uniform Resource Locator or URL) pointing to a script that is capable of loading the actual document.

Claims 2, 6 and 17-34 depend from independent Claim 1. Claim 1 is recited hereinabove.

As discussed above, Hull does not describe or suggest the method recited in Claim 1. Berchtold does not make up for the deficiencies of Hull. Accordingly, for at least the reasons set forth above, Applicant respectfully submits that Claim 1 is patentable over Hull in view of Berchtold.

When the recitations of Claims 2, 6 and 17-34 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 2, 6 and 17-34 likewise are patentable over Hull in view of Berchtold.

For at least the reasons set forth above, Applicant respectfully requests that the rejection of Claims 2, 6 and 17-34 under 35 U.S.C. § 103(a) be withdrawn.

In addition to the arguments set forth above, Applicant also respectfully submits that the Section 103 rejection of Claims 2, 6 and 17-34 is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Hull using the teachings of Berchtold. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combinations. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143 .01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the

present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Neither Hull nor Berchtold, considered alone or in combination, describe or suggest the combination(s) in Claims 2, 6 and 17-34. Rather, the Section 103 rejection of Claims 2, 6 and 17-34 appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Hull describes an email document archival system that includes an email hub that sends a copy of every message sent and received by a user, including the origin and destination addresses and the date and time of transmission, to the document management workstation for archiving purposes; and Berchtold describes an architecture for archiving and retrieving and classifying documents into collections by sending emails to recipients, retrieving messages from folders, and classifying messages into folder hierarchies. Since there is no teaching nor suggestion for the combination of Hull and Berchtold, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason also, Applicant requests that the Section 103 rejection of Claims 2, 6 and 17-34 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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